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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,088	07/12/2001	Peter K. Malkin	YOR9-2001-0331 (8728-517)	1876
46069	7590	12/30/2004	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 12/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,088

Applicant(s)

MALKIN ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-19,21-23,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-19,21-23,25 and 26 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/29/2004 has been entered.

Response to Amendment

Amendment received on 11/29/2004 is acknowledged and entered. **Claims 2, 4, 20 and 24** have been canceled. **Claims 1, 5-7 and 9** have been amended. **Claims 1, 3, 5-19, 21-23 and 25-26** are currently pending in the application.

Claim Objections

Claims 5-7 are objected to because of the following informalities: the phrase "The method of claim 4 1" should be substituted for "The method of claim ~~[[4]]~~ 1". The deleted text must be shown by strikethrough, with two exceptions:

for deletion of five or fewer consecutive characters, double brackets ~~[[]]~~ may be used ;

if strikethrough cannot be easily perceived, deleted text must be shown by double brackets ~~[[]]~~ around the deleted text characters (*Revised Amendment Practice 37 CFR 1.121*).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 7-9, 13-16 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. (US 2002/0169686) (Zweben) in view of Godsey et al. (US 2002/0161651) (Godsey) and further in view of Jenkins (US 5,186,281).

Zweben et al. teach a method and system for using portable devices to provide merchandising information, comprising:

Claim 1. Zweben teaches a method and system for using portable devices to provide merchandising information, comprising:

Providing a customer with a mobile device and a corresponding customer identification (loyalty card) [0039]; said mobile device is configured to wirelessly communicate with a vendor central computer [0031]; [0032]; wherein the customer, using said mobile device, indicates specific product he/she would like to purchase (issues the electronic service request, including a purchase order, via the mobile device) [0042];

receiving product search criteria, consumer information and said indication regarding the specific product he/she would like to purchase [0041]; [0042].

Zweben does not teach *tracking a location of the mobile device issued to the customer; and delivering the product to a checkout register according to the location to which the mobile device is tracked.*

Godsey teaches a method and system for tracking consumers in a store environment, wherein tracking of said consumers and their shopping carts in a store environment is provided based on a position of a mobile device (battery powered RF or IR transmitter tag), issued to the customers, in relation to a plurality of sensors, wherein

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tracking information is then tied in with purchasing data at the checkout registers, [0019]; [0020].

Jenkins teaches a method and system for article selection and purchase in a retail establishment, including: a customer arrives to the store; the order of customer queuing is wirelessly communicated to the terminal station (C. 3, L. 39-41); the customer enters customer identification information (by means of a special card issued by the store) and product information (including desired quantity) he/she desires to buy (C. 4, L. 45-60); said product information includes a location information of said product (C. 3, L. 65 – C. 4, L. 6); the customer then moves to a final checkout zone to pay for the product (C. 6, L. 5-7, 22-28); while the customer is moving to the final checkout zone, the selected articles have been transported to the finalizing terminal (34) (C. 6, L. 10-18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben to include tracking the customer within the store, as taught by Godsey, because collected thereby information would advantageously allow merchants to better utilize a store floor space. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben and Godsey to include delivering the selected by the customer products from the location of selection to the checkout register, as disclosed in Jenkins, because it would advantageously allow to avoid congestion arising from use of grocery carts in narrow aisles, and, thereby, allow the merchants to better utilize the store floor space.

Furthermore, Zweben teaches:

Claim 3. Issuing the customer a mobile device, wherein the mobile device determines the product identifier [0039].

Claim 7. Storing the service request in a customer database corresponding to the customer identification [0039]; [0042].

Claim 8. Said method and system, wherein the product identifier is determined according to one of a product radio frequency identification tag, a bar code scan, a

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verbal description provided by the customer, a digital photo, and an alphanumeric identification [0043].

Claim 9. Zweben teaches said method and system, comprising:

Providing a customer with a mobile device [0039]; said mobile device is configured to wirelessly communicate with a vendor central computer [0031]; [0032]; wherein the customer, using said mobile device, indicates specific product he/she would like to purchase (issues the electronic service request, including a purchase order, via the mobile device) [0042];

retrieving data from a database regarding said specific product the customer would like to purchase [0042];

processing said data regarding said specific product the customer would like to purchase [0042];

in response to the electronic service request, transmitting an electronic reply to the mobile device regarding said product identified by the customer [0041]; [0042].

Zweben does not teach *tracking a location of the mobile device issued to the customer*; and *delivering the product to a checkout register according to the location to which the mobile device is tracked*.

Godsey teaches a method and system for tracking consumers in a store environment, wherein tracking of said consumers and their shopping carts in a store environment is provided based on a position of a mobile device (battery powered RF or IR transmitter tag), issued to the customers, in relation to a plurality of sensors, wherein tracking information is then tied in with purchasing data at the checkout registers, [0019]; [0020].

Jenkins teaches a method and system for article selection and purchase in a retail establishment, including: a customer arrives to the store; the order of customer queuing is wirelessly communicated to the terminal station (C. 3, L. 39-41); the customer enters customer identification information (by means of a special card issued by the store) and product information (including desired quantity) he/she desires to buy (C. 4, L. 45-60); said product information includes a location information of said product

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(C. 3, L. 65 – C. 4, L. 6); the customer then moves to a final checkout zone to pay for the product (C. 6, L. 5-7, 22-28); while the customer is moving to the final checkout zone, the selected articles have been transported to the finalizing terminal (34) (C. 6, L. 10-18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben to include tracking the customer within the store, as taught by Godsey, because collected thereby information would advantageously allow merchants to better utilize a store floor space. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben and Godsey to include delivering the selected by the customer products from the location of selection to the checkout register, as disclosed in Jenkins, because it would advantageously allow to avoid congestion arising from use of grocery carts in narrow aisles, and, thereby, allow the merchants to better utilize the store floor space.

Claim 13. Godsey teaches said method and system, wherein said tracking is based on a position of a mobile device (battery powered RF or IR transmitter tag) in relation to a plurality of sensors [0019]; [0020]. The motivation to combine Zweben with Godsey would be to enable merchants to better utilize a store floor space.

Claim 14. Godsey teaches said method and system, wherein a server stores positions over time as position data [0023]. The motivation to combine Zweben with Godsey would be to analyze the collected location information to better utilize a store floor space.

Claim 15. Godsey teaches said method and system, including logging the position data, and processing the said data for a pattern movement [0023].

Furthermore, Zweben teaches:

Claim 16. Said method and system, wherein the product identifier is determined according to one of a product radio frequency identification tag, a bar code scan, a verbal description provided by the customer, a digital photo, and an alphanumeric identification [0043].

Claims 21 and 23. Receiving a customer query from a customer within a sales environment [0041]; [0047]. Information as to *the specific content of the query, including a digital photo or a voice memo*, is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Zweben, Godsey and Jenkins would be performed the same regardless if said customer query includes a digital photo, or not.

Claim 22. Receiving a customer query from a customer within a sales environment [0041]; [0047]. Information as to *one of a digital photo and a voice memo* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Zweben, Godsey and Jenkins would be performed the same regardless if said customer query is a question, a digital photo or voice memo.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben in view of Godsey, further in view of Jenkins and further in view of Lefkowitz (US 2002/0188501).

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Claim 5. Zweben teaches said method and system, wherein the loyalty card (customer identification) is issued to the customer [0039].

However, Zweben, Godsey and Jenkins do not specifically teach that said identification *is persistent*.

Lefkowitz teaches a method and system for providing rebates based on purchases made at participating retailer locations, wherein a customer is provided with a customer identification badge containing customer identification information, and wherein said badge comprises a persistent memory module for storing said customer identification information [0020].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben, Godsey and Jenkins to include that said identification is persistent, as taught by Lefkowitz, because it would advantageously enhance the reliability of the system.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben in view of Godsey, further in view of Jenkins and further in view of Official Notice.

Claim 6. Zweben teaches said method and system, wherein the loyalty card (customer identification) is issued to the customer and which is used at the time of service request [0039].

However, Zweben, Godsey and Jenkins do not specifically teach that said loyalty card (customer identification) *is issued with the service request*.

Official Notice is taken that it is well known that store loyalty cards or credit cards are offered to customers when the customers are shopping in the store.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben, Godsey and Jenkins to include that said loyalty card (customer identification) is issued with the service request, because it would advantageously allow merchants to collect information about customer shopping

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activity so to provide said customers with targeted advertisement in future based on said collected information, thereby increase revenue.

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben in view of Godsey, further in view of Jenkins and further in view of Saito et al. (US 2001/0014870) (Saito).

Claim 10. Zweben teaches said method and system, wherein the customer identification and the mobile device are issued to the customer [0039].

However, Zweben, Godsey and Jenkins do not specifically teach that said *customer identification associates the mobile device with the customer*.

Saito teaches a method and system for electronic coupon management using radio LAN, including a portable terminal carried around by a customer in the store, wherein when the portable terminal (terminal ID) is properly registered, a user registration confirmation message is issued [0115]; [0093].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben, Godsey and Jenkins to include that said customer identification associates the mobile device with the customer, as taught by Saito, because it would advantageously allow to use only one mobile device for a household, thereby reducing costs associated with the mobile device.

Claim 11. Saito teaches said method and system, wherein the database stores the association between the mobile device and the customer [0115]; [0093]. The motivation to combine Zweben, Godsey and Jenkins with Saito would be the ability to use only one mobile device for a household, thereby reducing costs associated with the mobile device.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben in view of Godsey, further in view of Jenkins, further in view of Saito and further in view of Official Notice.

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Claim 12. Zweben, Godsey, Jenkins and Saito teach making the association between the mobile device and the customer upon issuing the mobile device to the customer (See claim 10 and claim 11).

However, Zweben, Godsey, Jenkins and Saito do not specifically teach *breaking the association of the mobile device with the consumer upon return of the mobile device to the business.*

Official Notice is taken that it is well known in a communication service industry to retain business equipment when a customer brakes a contract for said communication services.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben, Godsey, Jenkins and Saito to include breaking the association of the mobile device with the consumer upon return of the mobile device to the business, because it would advantageously allow the business to use the same mobile device over and over again with new consumers, thereby saving funds.

Claims 17, 19 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben in view of Ambrose et al. (US 2002/0065879) (Ambrose).

Claim 17. Zweben teaches said method and system, comprising: receiving user query via the mobile device; storing customer query (adding the customer query to a query queneue); determining a response to the customer query; and delivering the response to the mobile device [0039]; [0041].

Zweben does not specifically teach *delivering an acknowledgment to the mobile device* confirming the receipt of the customer query.

Ambrose teaches a method and system for transferring service requests and responses to the requests between a client and an enterprise server, including acknowledging receipt of the service request [0339].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben to include acknowledging receipt of the customer query, as taught by Ambrose, because it would advantageously ensure the customer that his/her request went through, thereby improving customer service.

Claim 19. Zweben teaches: receiving information including indication regarding a specific product the customer would like to purchase (a purchase order) [0042]; in response to the electronic service request, transmitting an electronic reply to the mobile device regarding said product identified by the customer [0041]; [0042].

Claim 25. Ambrose teaches: acknowledging receipt of the service request [0339]. The motivation to combine Zweben with Ambrose would be to ensure the customer that his/her request went through, thereby improving customer service. Information as to *the specific content of said "acknowledging", including indication of the a number of preceding queries in the query queue*, is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 26. Zweben teaches: receiving a customer query from a customer within a sales environment [0041]; [0047]. Information as to *the specific content of the query, including a digital photo or a voice memo*, is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Zweben and Ambrose would be performed the same regardless if said customer query includes a digital photo, or not.

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Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben in view of Ambrose and further in view of Yacoby et al. (US 6,516,311) (Yacoby).

Claim 18. Zweben and Ambrose teach all the limitations of claim 18, except: *parsing the customer query for at least one key word; and retrieving a response corresponding to the key word from a database.*

Yacoby teaches a method and system for linking and directory assisting on the Internet, wherein a customer query is parsed for key words to retrieve matching information from a database (C. 5, L. 56-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben and Ambrose to include parsing the customer query for key words, as taught by Yacoby, because it would advantageously enhance the accuracy of matching the retrieved information to the consumer request.

Examiner's Notes

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

A "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments

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as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 5-19, 21-23 and 25-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

US patent 5,890,136 to Kipp teaches quick stop mass retail system for purchasing articles from a remote location for pick-up said articles at a store.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Igor Borissov
Patent Examiner
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A handwritten signature in black ink, appearing to read 'Igor Borissov', with a large, stylized loop at the end.

IB

12/27/2004